

Claims 21-71 are all the claims pending in the application. No claims are currently amended, newly added, or cancelled by this Amendment. In view of the following comments, reconsideration and allowance of all the claims pending in the application are respectfully requested.

Rejections Under 35 U.S.C. §102

Claims 21-71 stand rejected under 35 U.S.C. §102(e), as allegedly being anticipated by Smith et al. (U.S. Patent No. 6,529,903). Applicants respectfully traverse this rejection on the following basis.

Claim 21 recites, among other things, enabling the wireless client device to specify search criteria, wherein the search criteria include instructions to search one or more selected fields of the messages. Independent claims 36, 48, and 62 include similar recitations, among other things.

In an exemplary embodiment, the invention may provide search capabilities on a wireless client device (the specification at page 3, line 11). Search criteria may include searching messages (e.g., emails, memos, and/or other correspondences and documents) based on various fields such as sender, date, subject and other parts of a message (the specification at page 3, lines 11-14).

To anticipate a claim under 35 U.S.C. § 102, the reference must expressly or inherently disclose every element of the claim (M.P.E.P. § 2131.01). The Examiner admits that Smith does not disclose enabling the wireless client device to specify search criteria, wherein the search criteria include instructions to search one or more selected fields of the messages (the final Office Action at page 3, lines 3-5). Therefore, the rejection under 35 U.S.C. § 102(e) as being anticipated by Smith is improper at least for failing to disclose all of the elements of the claimed invention.

Accordingly, the finality of the pending Office Action must be withdrawn and prosecution reopened due to the improper rejection. Further, claims 22-35, 37-47, 49-61, and 63-71 depend from corresponding ones of claims 21, 36, 48, and 62, and are therefore allowable based on their dependency, as well as for the features that they add to the independent claims.

The Examiner improperly relies on a secondary reference, U.S. Patent No. 5,944,787 to Zoken, in making the § 102 rejection. The Examiner alleges that the inclusion of the search engine taught in Zoken into the system of Smith would cure the deficiency of Smith. For the reasons discussed above, the combination of references is improper in a § 102 rejection. However, even if the system of Smith were modified to include the search engine of Zoken, as proposed by the Examiner, the combination would not teach all of the features of the claimed invention.

More specifically, the Examiner asserts that Zoken teaches a known search engine that allows "searching postings to public forums including by name, organization, and email address," (the final Office Action at page 3, lines 9-11 (quoting Zoken at col. 1, line 67 - col. 2 line 1)). Applicant's note that the disclosure relied upon by the Examiner appears to include a cursory description of a prior art system in Zoken that provides no teaching whatsoever with respect to searching selected fields of a message. Instead, the cited passage of Zoken appears to teach that postings to public forums may be searched by a name, an organization, and/or an email address. However, no reference is made to searching selected fields of a message.

Therefore, the rejection of independent claim 21 is improper at least because Smith and Zoken, both alone and in combination, do not teach enabling the wireless client device to specify search criteria, wherein the search criteria include instructions to search one or more selected fields of the messages. Accordingly, the rejection of claim 21 must be withdrawn. Similarly, the rejections of independent claims 36, 48, and 62 must be withdrawn. Further, claims 22-35, 37-47, 49-61, and 63-71 depend from corresponding ones of claims 21, 36, 48, and 62, and are therefore allowable based on their dependency, as well as for the features that they add to the independent claims.

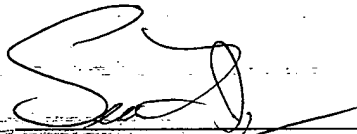
Customer Number
00909

Application Serial No.: 09/750,301
Attorney Docket No.: 042846-0313425
Request for Reconsideration

Having addressed each of the foregoing rejections, it is respectfully submitted that a full and complete response has been made to the Office Action and, as such, the application is in condition for allowance. Notice to that effect is respectfully requested. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Dated: December 30, 2004

Respectfully submitted,



Sean L. Ingram

Customer No. 00909

Registration No.: 48,283
PILLSBURY WINTHROP LLP
1600 Tysons Blvd.
McLean, VA 22102
703-905-2107